

Doc Code: AP.PRE.REQ

PTO/SB/33 (07/05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

68.0382 (SHL.0295US)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR

on March 1, 2007

Signature

Typed or printed name

Janice Munoz

Application Number

10/740,016

Filed

12/18/2003

First Named Inventor

Paul J.G. Van Wulfften Palthe

Art Unit

3672

Examiner

Nicole A. Coy

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 40,779

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Fred G. Pruner, Jr.

Typed or printed name

(713) 468-8880

Telephone number

March 1, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicants:	Paul J.G. Van Wulfften Palthe	§	Art Unit:	3672
Serial No.:	10/740,016	§		
Filed:	December 18, 2003	§	Examiner:	Nicole A. Coy
Title:	RIGLESS ONE-TRIP SYSTEM	§	Docket No.	68.0382 (SHL.0295US)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant seeks pre-appeal review of the §§ 102 and 103 rejections of claims 1-18 and 29-34 based on the following reasons.

The system of claim 1 includes a production tubing and a screen assembly, which are adapted to be run downhole as a unit in a single trip. The screen assembly is adapted to be engaged by a continuous medium, which is received by the production tubing to cause the release and movement of the screen assembly relative to the production tubing.

Claim 1 stands rejected under § 102(b) as being anticipated by King. However, a *prima facie* case of anticipation has not been set forth for claim 1 for at least the reason that King fails to teach the screen assembly of claim 1.

Date of Deposit: March 1, 2007

I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Janice Munoz

Contrary to the limitations of claim 1, King discloses screens 24 (see Fig. 2B), none of which are adapted to be engaged by a continuous medium that is received by a production tubing that is run downhole with the screens 24. Instead, the screens 24 are an integral part of a flow conductor service string 38 (see, for example, King, 7:62-68 and 8:1-2); and King fails to disclose engaging any of the screens by a continuous medium that is received by the flow conductor service string 38. King also fails to teach engaging any of screens 24 with a continuous medium such that the continuous medium causes the *release and movement* of the screen 24 relative to a production tubing. It is illogical that any of the screens 24 may be released and moved relative to a production tubing that is run downhole with the screens 24 when King shows and describes the screens 24 as being part of and thus, fixed to the flow conductor service string (which is assumed to be the alleged production tubing).

To summarize, although King discloses a screen, there is no teaching or even a suggestion in King regarding a screen assembly that is adapted to be engaged by a continuous medium that is received by a production tubing that is run downhole with the screen assembly; and likewise, there is no teaching or even a suggestion in King of a screen assembly that is adapted to be released by the continuous medium, such that the screen assembly moves with respect to the production tubing. Therefore, for at least any of these reasons, King fails to anticipate independent claim 1. Claims 2-18 are patentable for at least the reason that these claims depend from an allowable claim.

Claim 29 stands rejected under § 103 in view of Lund. However, Lund fails to teach or suggest providing a one-trip completion system that includes at least a perforating gun and a production tubing; and Lund fails to teach or suggest performing the claimed acts with such a one trip completion system. The Examiner states, "Lund does disclose that one-trip completion systems with production tubing and perforating guns are known in the art." Final Office Action, 11. Even assuming, for purposes of argument, that the statement is correct, the Examiner fails to establish a *prima facie* case of obviousness.

More specifically, a *prima facie* case of obviousness requires that the cited art teach or suggest all claim limitations. Claim 29 sets forth actions that are performed with a one-trip completion system, which includes a perforating gun and a production tubing. Contrary to the Examiner's untenable position, Lund discloses running a production tubing string into a well *after* a perforating and packing assembly has been positioned in the well (*emphasis added*). See,

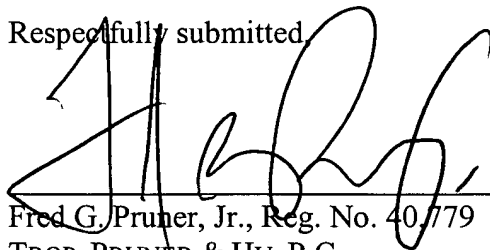
for example, Lund, 6:19-23 and 8:18-23. Thus, Lund fails to teach or suggest providing the claimed one-trip completion system. Lund also fails to teach or suggest such acts as running the claimed one-trip completion system in a well; and activating and operating such a one-trip completion system using a continuous medium that is run downhole into the one-trip completion system after the removal of a rig. The Examiner merely concludes a case of obviousness by alluding to the general knowledge of skill in the art for the purported suggestion or motivation to modify Lund to derive the missing claim limitations. Rarely, can the general level of skill in the art be relied on to support a case of obviousness. *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999). In *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988), the Federal Circuit held that the Examiner had failed to establish a *prima facie* case of obviousness for not showing where the prior art taught or suggested all claim limitations. A *prima facie* case of obviousness requires objective evidence, not mere speculation by the Examiner. *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Therefore, for at least the reason that the Examiner fails to set forth where the prior art teaches or suggest the missing claim limitations, a *prima facie* case of obviousness has not been established for claim 29. Claims 30-34 are patentable for at least the reason that these claims depend from an allowable claim.

CONCLUSION

In view of the foregoing, withdrawal of the §§ 102 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0295US).

Respectfully submitted,



Date: March 1, 2007

Fred G. Pruner, Jr., Reg. No. 40,779
TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TEXAS 77057
713/468-8880 [Phone]
713/468-8883 [Fax]